

REMARKS

The above Amendments and these Remarks are submitted under 35 U.S.C. § 132 and 37 C.F.R. § 1.111 in response to the Office Action mailed March 11, 2008.

Summary of the Examiner's Action and Applicants' Response

The Examiner objected to the drawings. Claims 1-8 and 19-25 were rejected under 35 U.S.C. § 112, second paragraph. The Examiner rejected Claims 17, 33, and 51 under 35 U.S.C. § 112, sixth paragraph. Claims 1-8, 17, 18, 19-25, 33-34, and 51-52 were rejected under 35 U.S.C. § 101 for being directed to non-statutory subject matter. Claims 1-5, 9-13, 17-22, 26-29, 33-39, 43-47, and 51-52 were rejected under 35 U.S.C. § 102(b) as being anticipated by Landsman, et al. (U.S. Patent No. 6,317,761) ("Landsman"). The Examiner rejected Claims 6-8, 14-16, 23-25, 30-32, 40-42, and 48-50 under 35 U.S.C. § 103(a) as being obvious based on Landsman in view of Galomb (U.S. Pat. App. Pub. 2001/0039510).

In this Amendment, Applicants have amended the Specification to correct a typographical error and to delete the Cross Reference to Related Applications section which is not applicable. Claims 1, 9, 17, 18, 19, 26, 33, 34, 35, 43, 51, and 52 have been amended. Applicants traverse the rejections. Claims 1-52 are pending.

Response to the Objection to the Drawings

The Examiner objected to the drawings because reference character "20" has been used to designate both a network and a system. In response, Applicants have amended the Specification to correctly identify 20 as a system, consistent with FIG. 1. No new matter has been added. Applicants respectfully request, therefore, that the objections to the drawings be withdrawn.

Response to the Rejection of Claims 1-8, 19-25 under 35 U.S.C. 112, second paragraph

The Examiner rejected Claims 1-8, 19-25 under 35 U.S.C. 112, second paragraph, as being indefinite; stating that the claims appear to be "hybrid" claims. The Examiner stated that "[t]he preamble claims a computer program, but the body of the claim refers to the method steps ('providing', 'assigning', etc). This renders the claim indefinite, since it is unclear what the claimed subject matter is". Applicants respectfully disagree. It is respectfully submitted that the preambles of Claims 1 and 19 recite "a method", in the preamble, not a computer program, as stated by the

Examiner. Further, Applicants respectfully submit that Claims 1 and 19 include method steps, therefore, the claims are proper method claims, not hybrid claims. Claims 2-8 depend directly or indirectly from Claim 1 and are thus respectively submitted as not being indefinite for the same reasons as given for Claim 1 above. Claims 20-25 depend directly or indirectly from Claim 19 and are thus respectively submitted as not being indefinite for the same reasons as given for Claim 19 above.

Response to the Rejection of Claims 17, 33 and 51 under 35 U.S. C. § 112, sixth paragraph

The Examiner rejected Claims 17, 33, and 51 under 35 U.S.C. § 112, sixth paragraph. The Examiner stated that "the claim recites the limitation 'means for receiving..., means for determining..., means for assembling ...' Examiner is unsure if the means for is referring to any hardware since apparatus is still referring to software, pro se". Applicants respectfully disagree.

Applicants respectfully submit that Claims 17, 33, and 51 are system claims and the structure for the "means for" elements is disclosed in the Specification and drawings. More specifically, Claim 17 includes means for receiving a creative definition; means for determining if the creative definition is a programmable or non-programmable creative definition; means for assembling, if the creative definition is a non-programmable creative, the non-programmable creative; and means for executing, if the creative definition is a programmable creative, the programmable creative definition to generate the creative. Applicants respectfully submit that FIG. 1 shows elements of the overall system 20 including advertising system processor 26. Applicants respectfully submit that FIG. 5 describes an embodiment of the programmable creatives assembly process related to the means in Claim 17. As described in the Specification for the embodiment in FIG. 5, "... the creative definition is analyzed (step 62) by advertising system processor 26 to determine if it is a creative to be formed by a program, that is a programmable creative in accordance with the present invention, or a traditional, non-programmable creative". Thus, Applicants respectfully submit that the advertising system processor 26 is hardware, apparatus of a system, e.g., in FIG. 1. Further with regard to the corresponding hardware, apparatus structure of the system, the Specification discloses that "[a]dvertising system processor 26 comprises any conventional computer, for example a personal computer, server or mainframe, capable of performing the functions described below. Similarly, advertising database 28 and proprietary database 29 comprise any conventional storage system for storing the data described below ...".

(Page 7, lines 1-4). Applicants respectfully submit that the Specification further describes regarding the system in FIG. 1, "[f]irewall 32 and web server 34 are conventional components known to those skilled in the art, the firewall providing network communications security and the web server providing an interface between client-side system 24 and server-side system 22".

For at least the reasons given above, Applicants respectfully submit that the corresponding structure for the means elements in Claims 17, 33, and 51 are disclosed in the Specification.

Response to the Rejection of Claims 1-8, 17, 18, 19-25, 33-34, and 51-52 under 35 U.S.C. § 101

Claims 1-8, 17, 18, 19-25, 33-34, and 51-52 were rejected under 35 U.S.C. § 101 for being directed to non-statutory subject matter. The Examiner stated that "[t]he claims appear to be claiming 'software systems' i.e., systems without hardware indication, which is a computer program per se. Since the claims disclose computer program per se that is not embodied on a computer readable medium, they appear non-statutory".

Applicants have amended Claims 1, 17, 19, 33, 34, and 51 to emphasize that at least one creative definition is stored in at least one computer readable storage medium. Per M.P.E.P. 2106.01, functional descriptive material such as data structures or computer programs, when recorded on some computer readable medium, including an electromagnetic carrier signal, become structurally and functionally interrelated to the medium and will be statutory in most cases "since use of technology permits the function of the descriptive material to be realized." Applicants respectfully submit, therefore, that Claims 1-8, 17, 18, 19-25, 33-34, and 51-52 are directed to statutory subject matter.

As an aside, Applicants points out that the Examiner included in the Office Action, for reference, a "section from MPEP 2105" that started with "(a) Function Descriptive Material ...". Applicants respectfully points out, for the record, that the section quoted in the Office Action is from M.P.E.P. § 2106.01 part I, not M.P.E.P. § 2105.

Response to the Rejection of Claims 1-5, 9-13, 17-22, 26-29, 33-39, 43-47, 51, and 52 under 35 U.S.C. § 102(b)

Claims 1-5, 9-13, 17-22, 26-29, 33-39, 43-47, and 51-52 were rejected under 35 U.S.C. 102(b) as being anticipated by Landsman. The Examiner stated that Landsman teaches all the steps including the step of "receiving a creative definition; (Column 3, lines 45-61; Column 17, lines 37-

52)"; "determining if the creative definition is a programmable or non-programmable creative definition; (Column 3, lines 45-61 ; Column 17, lines 37-52: Browser has the ability to determine if the embedded code is a banner or is a javascript program)"; and "assembling, if the creative definition is a non-programmable creative, the nonprogrammable creative; and (Column 3, lines 45-61: Discloses obtaining the graphic to be rendered)"; and "executing, if the creative definition is a programmable creative, the programmable creative definition to generate the creative. (Column 17, lines 37- Col 20, line 17: Discloses reading the advertising tag and executing the JavaScript code associated with the advertisement)".

Applicants have amended Claim 1 to emphasize that the steps for generating of the creative are on the server-side system. Applicants respectfully submit that Landsman teaches a client-side programmable technology using javascript programs authored on the server side, **but delivered and executed on the client side**. (See FIG. 1E, Col. 3, lines 45-61). It is respectfully submitted that Landsman does the method for generating a creative on the server-side, as claimed in Claim 1. Applicants respectfully submit that, among other things, Landsman does not teach determining on the server side system if the creative definition is a programmable or non-programmable creative definition; assembling on the server-side system, if the creative definition is a non-programmable creative, the non-programmable creative; and executing on the server-side system, if the creative definition is a programmable creative, the programmable creative definition to generate the creative, as claimed in Claim 1. For all of the above reasons, Applicants respectfully submit that Claim 1 is not anticipated by Landsman.

Further, regarding the role of the client-side system, Claim 1 does not include, but certain embodiments do, having the generated creative sent by the server-side system to the client-side system.

Further, client side programmable technology, such as disclosed in Landsman, was described in the background of the Specification of the present application, see e.g., page 3, as having drawbacks overcome by the present invention. In contrast to the client-side programmable technology, such as javascript taught in Landsman, at least some embodiments of the present invention are directed to developing server-side creatives, i.e., advertising content, that is assembled in response to the operation of a server-side program. (See Page 8, lines 9-20). As stated in the present Specification, client side programmable creatives that typically require special client-side web browser plug in software and resources to execute; however, server-side programmable

creatives require no additional client-side software or resources; perhaps more importantly, they have access to the publisher's private, internal data sources. (Page 3, lines 22-29).

Claims 2-5 depend directly or indirectly from Claim 1 and are thus respectfully submitted as not being anticipated by Landsman for the same reasons as given for Claim 1 above.

Claims 9, 17, 18, 19, 26, 33, 34, 35, 43, and 51 have been amended to emphasize that the generating of the creative is on the server-side system. Claim 9 is generally a system counterpart to Claim 1, and thus is respectfully submitted as not being anticipated by Landsman for the reasons given above for Claim 1. Claims 10-13 depend directly or indirectly from Claim 9 and are thus respectfully submitted as not being anticipated by Landsman for the same reasons as given for Claim 9 above.

Claim 17 is generally a system counterpart to Claim 1, and thus is respectfully submitted as not being anticipated by Landsman for the reasons given above for Claim 1. Claim 18 is generally a program product counterpart to Claim 1, and thus is respectfully submitted as not being anticipated by Landsman for the reasons given above for Claim 1.

Claim 19 is a method similar to Claim 1 and is respectfully submitted as not being anticipated by Landsman for the reasons given above for Claim 1. Claims 20-22 depend directly or indirectly from Claim 19 and are thus respectfully submitted as not being anticipated by Landsman for the same reasons as given for Claim 19 above.

Claim 26 is generally a system counterpart to Claim 19, and thus is respectfully submitted as not being anticipated by Landsman for the reasons given above for Claim 19. Claims 27-29 depend directly or indirectly from Claim 26 and are thus respectfully submitted as not being anticipated by Landsman for the same reasons as given for Claim 26 above.

Claim 33 is generally a system counterpart to Claim 19, and thus is respectfully submitted as not being anticipated by Landsman for the reasons given above for Claim 19. Claim 34 is generally a program product counterpart to Claim 19, and thus is respectfully submitted as not being anticipated by Landsman for the reasons given above for Claim 19.

Claim 35 is a method claim for a method for generating creatives on the server-side system. Applicants respectfully submit that Landsman teaches a client-side programmable technology using javascript programs authored on the server side, but delivered and executed on the client side. (See FIG. 1E, Col. 3, lines 45-61). Applicants respectfully submit that Landsman does not teach a method for generating creatives on the server-side system, as claimed in Claim 35. Claims 36-39

depend directly or indirectly from Claim 35 and are thus respectively submitted as not being anticipated by Landsman for the same reasons as given for Claim 35 above.

Claim 43 is generally a system counterpart to Claim 35, and thus is respectfully submitted as not being anticipated by Landsman for the reasons given above for Claim 35. Claims 44-47 depend directly or indirectly from Claim 43 and are thus respectively submitted as not being anticipated by Landsman for the same reasons as given for Claim 43 above.

Claim 51 is generally a system counterpart to Claim 35, and thus is respectfully submitted as not being anticipated by Landsman for the reasons given above for Claim 35. Claim 52 is generally a program product counterpart to Claim 35, and thus is respectfully submitted as not being anticipated by Landsman for the reasons given above for Claim 35.

**Response to the Rejection of Claims 6-8, 14-16, 23-25, 30-32, 40-42,
and 48-50 under 35 U.S.C. 103(a)**

The Examiner rejected Claims 6-8, 14-16, 23-25, 30-32, 40-42, and 48-50 under 35 U.S.C. 103(a) as being obvious based on Landsman in view of Galomb. The Examiner acknowledged that Landsman discloses the ability for an advertiser to change or update any of its advertisements by just modifying appropriate media and AdDescriptor files that reside in the third-party advertising management system. (Column 13, lines 55-66), however, Landsman does not disclose periodically changing text, an image, or a hyperlink within the creative, as claimed in Claim 1. The Examiner stated that Galomb discloses advertisement includes text, images, and/or hyperlinks. (Paragraph 0004). The Examiner stated that having Landsman et al. in conjunction with Galomb, an advertiser would have the ability to change its advertisements by modifying the text, image or hyperlink associated with the advertisement. The Examiner concluded that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to have modified Landsman with Galomb's advertising system to enable since it would have provided the benefit of the need for advertisers to directly and instantly control the testing and optimizing of their advertisements. Applicants respectfully disagree.

Applicants respectfully submit that the method in Claim 1 is non-obvious based on Landsman for the same reasons as given for Claim 1 above. Further, Applicants respectfully submit that Galomb does not teach or suggest generating a creative on the server-side as claimed in Claim 1. Applicants respectfully submit, therefore, that Landsman and Galomb, either singly or in any

theoretical combination, do not teach or suggest the method of Claim 1. Claims 6-8 depend directly or indirectly from Claim 1 and are thus respectively submitted as being non-obvious based on Landsman in view of Galomb for the same reasons given above for Claim 1.

Further, it is respectfully submitted that the mere disclosure in Galomb that an advertisement may have text and images and disclosing a testing method for such advertisements, does not teach or suggest the step of periodically changing text or images, as claimed in Claim 6. Applicants respectfully submit that Claim 6 is non-obvious based on Landsman in view of Galomb for this additional reason.

Claims 14-16 are generally system counterparts of Claims 6-8 and thus are respectfully submitted as being non-obvious based on Landsman in view of Galomb for the same reason given above for Claims 6-8.

Claims 23-25 are method claims similar to Claims 6-8 and thus are respectfully submitted as being non-obvious based on Landsman in view of Galomb for the same reason given above for Claims 6-8.

Claims 30-32 are generally system counterparts of Claims 6-8 and thus are respectfully submitted as being non-obvious based on Landsman in view of Galomb for the same reason given above for Claims 6-8.

Claims 40-42 are method claims similar to Claims 6-8 and thus are respectfully submitted as being non-obvious based on Landsman in view of Galomb for the same reason given above for Claims 6-8.

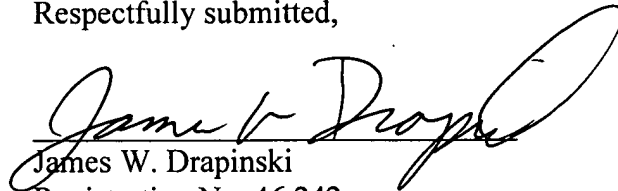
Claims 48-50 are generally system counterparts of Claims 6-8 and thus are respectfully submitted as being non-obvious based on Landsman in view of Galomb for the same reason given above for Claims 6-8.

Conclusion

For the above reasons, Applicants respectfully submit that all pending claims, Claims 1-52, in the present application are allowable. Such allowance is respectfully solicited.

If a telephone conference would expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (415) 984-8200.

Respectfully submitted,


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